

REMARKS

I. Introduction

In view of the above amendments and the following remarks, reconsideration of the rejections contained in the Office Action of February 19, 2009 is respectfully requested.

By this amendment claims 1 and 3 have been amended and claims 13-17 have been added. Claims 1-17 are now pending in the application. No new matter has been added by these amendments.

II. Prior Art Rejections

Currently, claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Yamamoto et al. (WO 03/050436, herein referred to as “Yamamoto”) and claims 5-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto in view of Kuznets et al. (US 5,700,214).

As discussed in the telephone interview of May 12, 2009, Applicants disagree with the prior art rejection set forth in the Office Action. In rejecting independent claims 1 and 3, the Examiner has interpreted a single structure in the prior art, resister ring 7 shown in figure 2 of Yamamoto, as corresponding to two distinct structures required by each of claims 1 and 3. Specifically, page 3 of the Office Action states that “there is no claim language requiring the retraction restrictor to be of a separate and distinct structure from that of the radially elastically deformable elastic ring.” To the contrary, binding legal precedent from the United States Court of Appeals for the Federal Circuit establishes that a claim requires multiple structures simply by virtue of the fact that the structures are recited in the claim with distinct terminology. *In re*

Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) (holding that a claim which recited three structures: a closure member, a landing member, and a disposal means, could not be anticipated by a prior art reference which taught only two structures, even where the two structures in the prior art were capable of performing all the functions on the three structures recited in the claim.)

In reversing the Board of Patent Appeals and Interferences, the Federal Circuit held that “the Board failed to recognize that the third mechanical fastening means in claim 76, used to secure the diaper for disposal, was separate from and independent of the two other mechanical means...” Thus Applicants respectfully submit that each of claims 1 and 3 require the retraction restrictor and the elastic ring to be separate and distinct structures simply by virtue of the fact that those claims each recite the two structures in distinct terms.

In an effort to advance prosecution, and without agreeing to the propriety of the Examiner’s rejection, claims 1 and 3 have been amended to explicitly require that the retraction restrictor mechanism and the elastic ring are separate and distinct structures. Specifically, claim 1 now requires that said retraction restrictor mechanism comprise a resistor ring, and that said resistor ring and said elastic ring constitute separate structures such that said elastic ring is operable to prevent axial movement of said plunger independent of said resistor ring. Claim 3 now requires that said retraction restrictor mechanism and said elastic ring constitute separate structures such that said elastic ring is operable to prevent axial movement of said plunger independent of said retraction restrictor mechanism. Both the Examiner and the Supervisory Examiner indicated during the telephone interview of May 12, 2009 that a claim amendment requiring that the retraction restrictor and the elastic ring constitute separate structures would overcome the Yamamoto reference. Accordingly, in light of the aforementioned amendments, Applicants respectfully request withdrawal of the rejections set forth in the Office Action.

The Kuznets et al. reference is cited for an alleged disclosure of a shape of the retainer ring; Kuznets et al. fails to cure the aforementioned deficiencies of Yamamoto. Further, it appears that there would have been no reason to modify any of the prior art of record to yield a configuration which would meet the requirements of claims 1 or 3.

It is thus submitted that the invention of the present application, as defined in claims 1 and 3, is not anticipated nor rendered obvious by the prior art, and yields significant advantages over the prior art. Allowance is respectfully requested.

Claims 2, 5-7, 10, 13-14, and 16 depend, directly or indirectly, from claim 1 and are thus allowable for at least the reasons set forth above in support of claim 1. Claims 4, 8-9, 11-12, and 15 depend, directly or indirectly, from claim 3 and are thus allowable for at least the reasons set forth above in support of claim 3.

Claim 17 requires a chain tensioner similar to that recited in claim 1, and also requires that the radially compressed state of said elastic ring constitutes a state in which said elastic ring is compressed by a force external to said elastic ring. In the interview of May 12, 2009, the Examiner stated that she interpreted the “radially compressed state” in claim 1 to be any state in which the elastic ring was smaller than an expanded state. Applicants submit that the above-described requirement of claim 17 precludes this interpretation. Accordingly, Applicants submit that the prior art of record, whether taken alone or in combination, fails to meet the requirements of claim 17; Allowance is respectfully requested.

In view of the foregoing amendments and remarks, inasmuch as all of the outstanding issues have been addressed, Applicants respectfully submit that the present application is now in condition for allowance, and action to such effect is earnestly solicited. Should any issues remain after consideration of the response, however, the Examiner is invited to telephone the

undersigned at the Examiner's convenience.

The Commissioner is authorized to charge any deficiency or to credit any overpayment associated with this communication to Deposit Account No. 23-0975, with the EXCEPTION of deficiencies in fees for multiple dependent claims in new applications.

Respectfully submitted,

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